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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,266	02/25/2002	Shoji Nakajima	3688KG-1	7101

22442 7590 07/25/2005

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EXAMINER
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LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/084,266

Applicant(s)

NAKAJIMA ET AL.

Examiner

Donald Loney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 40-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/29/03, 03/01/05, 3/10/05</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 1, 2005 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 40, 48, 51 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmooch (5344692).

Schmooch teaches a first leather member 2 bonded to a second member 11 or 13 using a hot-melt 3 wherein at least a first portion of said first member is not in contact with the second member (i.e. on the sides and/or the bottom thereof), and wherein a second portion of said first member contacting said second member is thinner (i.e. any section from the rough surface 5 of the leather to the bottom thereof) than said first portion of said member (i.e. the thickness between the two side portions, which is the width thereof, which is much thicker than height thickness). No portion of the first

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member contains a through hole. Refer to figures 1 and 3 in along with column 3, lines 48-68, column 4, lines 1-17 and 43-65, column 5, lines 17-41, column 6, lines 37-65, column 8, lines 29-63 and column 9, lines 1-17.

4. Claims 51 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Larmour (2237152).

Larmour teaches a first member 2 bonded to a second member 4 (i.e. inlaid metal piece) using a hot-melt. The applicant's language drawn to the "wherein at least a first portion of said first member is not in contact with the second member, and wherein a second portion of said first member contacting said second member is thinner than said first portion of said member, and wherein said second portion of said first member does not have a through hole" is applicant's language used to structurally define inlaid second members 11 in first member 203 as shown in figures 2a-c.

5. Claims 40, 48, 51 and 52 are<sup>1</sup> rejected under 35 U.S.C. 102(b) as being anticipated by Frohlich (2033066).

Frohlich teaches a first leather member 10 containing an inlaid (i.e. embedded) second member 16 using a hot-melt 12. The examiner has explained his position as to the various portions recited in the claims equating to an inlaid second member in a substrate, above.

6. Claims 40, 43, 48, 50, 51, 52, 53 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by LaPerre (5620775).

LaPerre teaches a substrate 75 (i.e. first member), which can be leather, containing inlaid glass members 71 (i.e. second member) attached to the substrate

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using a hot-melt 73. Refer to figure 7a along with column 13, lines 37-46, column 14, lines 6-16 and column 17 line 65 through column 18, line 28. Again, the examiner has explained his position as to the various portions recited in the claims equating to an inlaid second member in a substrate, above.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 40-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicants discussion of the prior art in view of Poll (5338591).

In the applicants discussion of the prior art (figures 3 and 4) it is discussed that it is known to attach a second member 11, made of glass, to a first member 13 or 203, made of cloth or leather, using a hot-melt 12. The two prior art structures either attach the second member to a side of the first member which is flat (figure 3) or attach the second member with a through hole to the first member (figure 4). The applicants' invention is in inlaying (i.e. impressing) the second member in the first member (i.e. it is attached as per the various portions recited and explained as equating to an inlaid structure above). The prior art also shows the water-proof coating 202 applied to the leather substrate.

Poll teaches to improve the mounting of gems (i.e. glass pieces) by impressing the gem into a fabric substrate, versus the prior arts mounting the gem on a flat

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substrate. This is the prior art the applicant is discussing in figure 3. Refer to figure 1 showing gem 5 inlaid in fabric substrate 3 along with column 1, lines 14-24, column 3, lines 19-65. The layers 2 and/or 4 used to attach the gem are not specifically disclosed as a hot-melt, but are disclosed as having adhesive properties.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the prior art to inlay the glass pieces into the leather or fabric, as taught by Poll, motivated by the fact Poll teaches to inlay the gems, versus to just attach them to a flat layer, for the purpose of providing improved adhesion of the gem to the substrate.

### ***Response to Arguments***


9. Applicant's arguments filed March 1, 2005 have been fully considered but they are not persuasive. The applicant argues that the layers in Schmooock are continuous and unbroken, and therefore, at least a portion of the first member is not in contact with the second member. However, the examiner pointed out portions which are not in contact with the second member (i.e. the sides and/or bottom) which would read upon the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donald Loney  
Primary Examiner  
Art Unit 1772

DJL:D.Loney  
07/20/05